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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,544	07/16/2003	Ruediger Tueshaus	Dorstener-002	8429

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EXAMINER

SPERTY, ARDEN B

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/620,544

Applicant(s)

TUESHAUS ET AL.

Examiner

Arden B. Sperty

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-23 and 42-47 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 5-23 and 42-47 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **FINAL OFFICE ACTION**

1. Applicant's amendment and comments, submitted 10/17/05, have been entered and carefully considered. The previously stated prior art rejections in view of the FR 2808473 reference are withdrawn per Applicant's amendments to the claims. Despite this advance, the claims remain rejected in view of additional prior art, as detailed herein.

#### ***Claim Objections***

2. The objections to claims 5 and 7, as stated in the previous office action, are withdrawn. The examiner questioned use of the term "within." Applicant's amendment, and review of the specification (page 23, lines 14-17), render moot the previously stated objection.

#### ***Claim Rejections - 35 USC § 112***

3. Claims 5 and 16-20 were rejected under 35 USC 112, second paragraph, as being indefinite. The rejection remains, because Applicant's highly technical definition of a mesh is not a definition set forth in the specification, nor is the definition congruent with the Office's definition of a mesh. The Office's classification definition is included with this office action. The Office defines a mesh conventionally, which is to say that "mesh" is synonymous with "scrim." See definition of class 442, subclass 1, wherein "Scrim includes but is not limited to open net, mesh, gauze, loosely woven, or knitted fabrics. A characteristic of most scrims is the ability to see readily through the fabric from a distance." Clearly, a conventional mesh has openings, thus the claim language

requiring zero percent light transmission is indefinite. If Applicant intended to be his own lexicographer, the preferred definition of the term in question should have been provided in the specification. Applicant's convenient construal of a conventional term is not supported by the specification, nor is it found persuasive. Claims 5 and 16-20 remain rejected. New claims 42-44 and 46-47 are likewise rejected.

4. Claims 5, 16-20, 42-44, and 46-47 are also rejected under 35 USC 112, second paragraph, because "a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired." See MPEP § 2173.05(c). In the present instance, "zero or substantially zero" constitutes a broad limitation, followed by a narrow limitation. It is unclear where the lower endpoint of the range "zero or substantially zero to eighty-five percent" lies.

5. Claims 5, 16-20, 42-44, and 46-47 are also rejected under 35 USC 112, second paragraph, as being indefinite due to internal inconsistencies. The amended claims state that the wire mesh "permits light", then immediately states that the light transmission may be zero. If the light transmission is zero, then light is not being "permitted." The examiner recognizes that Applicant is making an effort to clarify the invention, but the claim language is unclear.

6. Claim 6 remains rejected under 35 USC 112, second paragraph. Applicant cites chicken wire as exemplary of wires looped completely around each other one or more times. But claim 6 also states that the wires are "not twisted"; the wire intersections of

chicken wire are twisted. Applicant also argues that conventional weaving systems cannot provide the intended structure, yet line 3 of the claim recites a "weave pattern." How do woven wires engage each other, not twist around each other, yet loop completely around each other one or more times? The claim is not rejected against prior art because the intended structure is incomprehensible.

7. Regarding the 35 USC 112, second paragraph, rejection regarding the Dutch and heddle weaves of claims 14 and 15, the examiner has revisited the specification to locate the pictures that Applicant refers to in the response (middle of page 10). Wire mesh 12B of Fig. 3 shows a three heddle weave, according to specification page 27, lines 18-19. The examiner respectfully submits that wire mesh 12B looks like a regular woven material. The illustration does not explain "heddle" weave. The specification also states that a Dutch weave is "shown herein" (specification page 27, lines 19-20), therefore an illustration is implied. An illustrative figure is not present. Applicant has not provided anything to define the terms. A search of material science references yielded an example of a Single Plain Dutch Weave wire filter mesh (Neale, M.J., The Tribology Handbook). The rejection of claim 14 is withdrawn, and the Single Plain Dutch Weave example is interpreted. There does not appear to be a universally accepted example of a heddle weave, thus claim 15 remains rejected.

8. The amendment to claim 21 does not clarify the structure. The claim recites a number of functional limitations, yet it is not apparent what means are intended for providing such features. For example, there is nothing definite in the description of an

assembly that is "bendable up to a permanent deformation or breaking point by a predetermined amount."

9. Furthermore, amended **claim 21 is rejected under 35 USC 112, first paragraph**, the negative limitation, requiring a "non-glass" material, is not enabled.

While there is nothing inherently ambiguous or uncertain about a negative limitation, the boundaries of the patent protection sought must be set forth definitely, albeit negatively, in the specification. The mere absence of a positive recitation is not basis for an exclusion. See MPEP 2173.05(i). Applicant is currently claiming an exclusion, without a teaching of any such exclusion. The claim is seen to contain a negative limitation which does not have basis in the original disclosure.

***Claim Rejections - 35 USC § 102/103***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 5, 7, 9, 11-12, 21-22, are rejected under 35 U.S.C. 102(b), as being anticipated by, or in the alternative, under 35 USC 103(a) as obvious in view of, US Patent 5998028 to Eckart et al.

13. The reference teaches a thermoplastic article which is a laminate comprising upper and lower sheet materials, with metallic wire, rods, or bars therebetween (col. 1, lines 11-22). The product may have varying degrees of transparency (col. 1, lines 38-40). The metallic element may be a transparent metal mesh fabric, screen, or open mesh, and may be woven, welded, knitted, or fabricated by other means (col. 3, lines 11-18). The metallic filaments, rods or bars may have varying cross-sectional diameters and/or colors, and may be made from a variety of metals (col. 3, lines 16-30). One side of the metallic mesh or screen will inherently be more reflective than the other side, depending on the type of weave. The burden is upon Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, it would have been obvious to provide desired, predictable, effects by varying the parameters as set forth in the prior art. *In re Best*, 195 USPQ 433.

Regarding claim 7, the reference teaches adhesives (col. 4, lines 41-44).

Regarding claim 9, planar wires, rods, or bars, are recited (col. 3, line 24).

The limitations of claims 11 and 12 are met due to the similar intended uses of the prior art (col. 3, lines 31-36; col. 6, lines 15-29).

As far as can be ascertained in view of the 35 USC 112, second paragraph, rejection of claim 21, the thermoplastic article of the prior art meets the limitations of the claim because it is formable (col. 6, lines 14+).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 8, 10, 13-20, 23, and 42-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5998028 to Eckhart, as applied to claim 5 above.

Regarding claims 8 and 42-47, the reference teaches varying cross-sectional areas and geometries (col. 3, lines 21-30). Although triangular cross-sections are not specified in the listed exemplary cross-sections, it would have been obvious for one of ordinary skill in the art to select a desired cross-section based on the ultimate intended effect. The same applies to the limitations of claim 10, and the twisting limitations of claims 23, and 42; it would have been obvious for one of ordinary skill in the art to select elements based on the ultimate, predictable, intended effect. The plurality of variables presented in column 3, lines 11-35 support the intent for one of ordinary skill in the art to design the decorative product as desired. Absent a showing of unexpected results, not just aesthetic preference, the selection of decorative modifications would have been obvious to one of ordinary skill or creativity in the art. A known type of woven or knitted mesh would also have been selected based on the ultimate, predictable, intended effect. The weaves of claims 13-16 are known in the art, per Applicant's admission, and therefore would have been obvious in view of the ultimate intended effect.



16. Regarding claims 17-20, it is the intention of the prior art for one of ordinary skill in the art to select preferred metallic elements (col. 3, lines 24-30), and the amount of light transmission would be a property of the diameter, shape, and weave/knit of elements selected for the mesh. Absent a showing of unexpected results, not just aesthetic preference, it would have been obvious to one of ordinary skill in the art to select a mesh with desired light transmission properties.

***Response to Amendment***

17. The amendments to the claims have overcome the previously stated prior art rejections. The FR 2808473 reference is not seen to teach or fairly suggest one side of the mesh being more reflective than the opposite side.

***Response to Arguments***

18. Applicant's arguments have been considered, but are moot because the rejections set forth in the previous office action are withdrawn. The rejections are withdrawn as a result of amendments to the claims.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden B. Sperty whose telephone number is (571)272-1543. The examiner can normally be reached on M-Th, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571)272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arden B. Sperty  
Examiner  
Art Unit 1771

January 9, 2006



CHERYL A. JUSKA  
PRIMARY EXAMINER